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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,487	08/22/2003	Kevin Wade Jameson	CFSTP014	8737

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EXAMINER
RADTKE, MARK A

ART UNIT	PAPER NUMBER
2165	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/645,487	JAMESON, KEVIN	
	Examiner	Art Unit	
	Mark A. X Radtke	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 July 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20030822*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Remarks

1. Examiner notes Applicant's letter dated 16 January 2004 re Voluntary Amendment. Examiner thanks Applicant for attempting to expedite the application process. Although the letter has been considered, no amendment has been made because no specific amendments citing specific page and line numbers to be amended have been cited. Applicant's definitions have helped the Examiner focus the prior art search, but the Examiner's rejection is based on the claims in light of the specification as filed. Examiner respectfully submits that Applicant's definition of "collection" (section 4.2 of "Voluntary Amendment") contains the word "collection" twice, creating what is commonly called a "circular definition" and which may be considered vague if it were supported in the specification. Applicant is reminded that amendments to the specification after filing may constitute "new matter."

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d

1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-2, 5-6 and 9-10 of the instant application are provisionally rejected under the judicially created doctrine of double patenting over claims 23-24 of copending Application No. 10/645,550.

Claims 1-2, 5-6 and 9-10 of the instant application are considered obvious over claims 23-24 of Patent Application No. 10/645,550.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting

because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus)." ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 1, line 2, the phrase "on or with the aid of a computer" renders the claim indefinite. It is unclear which steps are performed on a computer and which are not.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sundararajan (U.S. Pat. No. 6,487,577).

As to claim 1, Sundararajan teaches a Collection Symbolic Job Expander process for expanding a collection symbolic job request into a list of expanded job requests, to be performed on or with the aid of a computer (see Abstract), comprising the following steps:

(a) receiving a collection symbolic job request from a request originator to perform a collection job expansion action on said collection symbolic job request (see figure 6a and see column 7, lines 58-60, where "request originator" is read on "client" and where "collection symbolic job request" is read on "job"),

(b) performing said collection job expansion action on said collection symbolic job request using a collection symbolic job expander means to produce an expanded job list (see column 7, lines 15-17, where "performs" is read on "executes"),

(c) returning said expanded job list to said request originator (see column 7, lines 60-62),

thereby solving the Collection Symbolic Job Expansion Problem, and improving the productivity of people who process collections by enabling them to use a convenient symbolic job syntax for requesting complex processing tasks on large sets of collections (This limitation describes the problem to be solved by the invention and will not be given

patentable weight. For the same reason, the last limitation of every claim in the instant application will not be given patentable weight).

Sundararajan does not explicitly teach

wherein said collection symbolic job request is comprised of a symbolic task name and a collection reference expression, and wherein said expanded job list is comprised of a list of expanded job requests, each comprised of said symbolic task name, an expanded collection name, a computing platform name, and a collection visit order value.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The collection job expansion would be performed the same regardless of the data structure sent in the request. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, (see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)).

Therefore, it would have been obvious to a person of ordinary skill in the relevant art at the time the invention was made to perform the collection job expansion based on any type of request parameters, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of data does not patentably distinguish the claimed invention.

As to claims 2, 6 and 10, Sundararajan teaches wherein

(a) said step of performing said collection job expansion action uses information from a collection storage system to expand a collection reference expression (See column 3, lines 51-61. Specifically, the database look-up portion of the citation discloses an ID number that can be used to "provide the SC computer with information on [...] the job". See also column 4, lines 14-28.),

thereby solving the Collection Reference Expansion Problem, and thereby improving human productivity by enabling people to use convenient collection reference expressions to refer to sets of collections, without being responsible for knowing exactly which collections are members of said sets of collections.

As to claims 3, 7 and 11, Sundararajan does not explicitly teach wherein

(a) said step of performing said collection job expansion action uses information from a collection type definition to determine platform assignment information, and

wherein said collection type definition is a user-defined set of attributes that are useful to application programs for understanding and processing collections,

thereby solving the Collection Platform Assignment Problem, and thereby improving human productivity by enabling collection processing programs to automatically determine platform assignment details for collection job requests in ways that were not previously known to the art.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The collection job

expansion would be performed the same regardless of the data structure sent in the request. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, (see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)).

Therefore, it would have been obvious to a person of ordinary skill in the relevant art at the time the invention was made to perform the collection job expansion based on any type of request parameters, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of data does not patentably distinguish the claimed invention.

As to claims 4, 8 and 12, Sundararajan does not explicitly teach wherein

(a) said step of performing said collection job expansion action uses information from a collection specifier or from a collection type definition to determine collection visit order values, and

wherein collection specifiers contain information about collection instances, including collection type indicators and explicit visit order values, and wherein said collection type definition is a user-defined set of attributes that are useful to application programs for understanding and processing collections,

thereby solving the Collection Visit Order Problem, and thereby improving human productivity by enabling collection processing programs to automatically determine

collection visit order values to enforce processing dependencies among collections in a set, in ways that were not previously known to the art.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The collection job expansion would be performed the same regardless of the data structure sent in the request. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, (see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)).

Therefore, it would have been obvious to a person of ordinary skill in the relevant art at the time the invention was made to perform the collection job expansion based on any type of request parameters, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of data does not patentably distinguish the claimed invention.

As to claim 5, Sundararajan teaches a programmable Collection Symbolic Job Expander device for expanding a collection symbolic job request into a list of expanded job requests (see Abstract), whose actions are directed by software executing a process comprising the following steps:

For the remaining steps of this claim applicant(s) is/are directed to the remarks and discussions made in claim 1 above.

As to claim 9, Sundararajan teaches a computer readable memory, encoded with data representing a Collection Symbolic Job Expander computer program, that can be used to direct a computer when used by the computer (see Abstract), comprising:

For the remaining steps of this claim applicant(s) is/are directed to the remarks and discussions made in claim 1 above.

Additional References

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of art with respect to distributed collection management in general:

Patent/Pub. No.	Issued to	Cited for teaching
US 6195676 B1	Spix; George A. et al.	Scheduling
US 6226644 B1	Ciscon; Larry A. et al.	Intercomputer communication

Conclusion

9. Any inquiry concerning this communication or earlier communications should be directed to the examiner, Mark A. Radtke. The examiner's telephone number is (571)

272-7163, and the examiner can normally be reached between 9 AM and 5 PM, Monday through Friday.

If attempts to contact the examiner are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached at (571) 272-4146.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (800) 786-9199.

maxr
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1 October 2007

JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100